Supreme Court, U.S.
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IN THE

Supreme Court of the United States

INFINEON TECHNOLOGIES AG,
INFINEON TECHNOLOGIES NORTH AMERICA CORP., AND
INFINEON TECHNOLOGIES HOLDING NORTH AMERICA INC.,

Petitioners,

v.

RAMBUS, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR CERTIORARI

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QUESTIONS PRESENTED

This case involves the future of the industry that makes the memory chips found in virtually all the world's personal computers. Respondent Rambus participated in an industry standards-setting body that developed a new industry standard for such chips, while secretly amending its patent applications to cover the new standard. After the industry spent hundreds of millions of dollars implementing the new standard, Rambus turned around and demanded extortionate license fees. When petitioner Infineon refused to capitulate to this demand, Rambus sued Infineon for patent infringement and Infineon countersued for fraud. After construing the patent claims, the district court ruled against Rambus on its infringement claims as a matter of law, and, after a two-and-a-one-half week trial, a jury ruled in Infineon's favor on the fraud claim. The Federal Circuit, however, reversed on both scores, holding that (1) "substantial evidence" did not support the disclosure duty found by the jury as a *factual* matter, and (2) the district court had misconstrued the patent claims by, among other things, construing the critical claim term "bus" primarily by reference to the patent specification rather than a dictionary definition. This petition thus presents the following questions:

1. Whether the Federal Circuit is entitled to substitute its own view of the facts for the jury's in this landmark case, in violation of both the Seventh Amendment and basic norms of appellate procedure, such that summary reversal is appropriate.

2. Whether the Federal Circuit is entitled to reverse the rebuttal presumption endorsed by this Court in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), that a patent's specification provides the presumptive meaning of an ambiguous claim term, and replace it with a rebuttable presumption that a dictionary definition provides the presumptive meaning of such a term, thereby deepening an internal circuit split on this fundamental issue of patent law, and subverting the public-notice function of patent specifications.

RULE 29.6 STATEMENT

Petitioner Infineon Technologies AG is a publicly traded company with its headquarters in Germany. Infineon Technologies AG has no parent corporation. Siemens AG, a publicly held company, is the beneficial owner of 10% or more of Infineon Technologies AG's stock.

Petitioner Infineon Technologies North America Corp. is a wholly owned subsidiary of petitioner Infineon Technologies AG. No other publicly held company owns 10% or more of its stock.

Petitioner Infineon Technologies Holding North America Inc. is a wholly owned subsidiary of petitioner Infineon Technologies AG. No other publicly held company owns 10% or more of its stock.

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INTRODUCTION

The Federal Circuit was established in 1982 to bring greater uniformity and expertise to patent cases. But the Federal Circuit is still an Article III appellate court, bound by the same rules and procedures that govern all the other appellate circuits. The Federal Circuit does not sit as a federal appellate super-jury that is free to retry patent cases and to ignore the most basic rules of judicial procedure. This point is sometimes lost on the Federal Circuit, as illustrated by this Court's decision three Terms ago in *Nelson v. Adams USA, Inc.*, 529 U.S. 460 (2000), which unanimously reversed the Federal Circuit on the fundamental point that a party is entitled to be heard before the entry of judgment against it, and expressly compared the procedure sanctioned by the Federal Circuit to *Alice in Wonderland*, *see id.* at 468 n.2. And just the Term before that, this Court rejected "the Federal Circuit's claim for an exception" to the settled standards governing federal judicial review of administrative agency action. *Dickinson v. Zurko*, 527 U.S. 150, 154 (1999).

Here, the Federal Circuit has struck once again. The court not only reversed a fraud jury verdict against respondent on the ground that "substantial evidence" did not support the disclosure duty found by the jury as a matter of *fact*, but proceeded to order the entry of judgment in respondent's favor without even giving petitioners their day in court to litigate the case under the new disclosure duty. The court thereby violated the most basic norms of appellate procedure. As Judge Prost noted in her vigorous dissent, the jury was indisputably presented with ample testimony and written evidence supporting the disclosure duty found by the jury, and the panel majority simply substituted its own view of facts for the jury's. And instead of remanding for a new trial under the new duty, the panel majority simply declared that "substantial evidence does not support the implicit jury finding that [respondent] breached the relevant disclosure duty," App. 2a, and directed

the entry of judgment in respondent's favor as a matter of law, even though there could have been no "implicit" jury finding regarding a breach of the "relevant" disclosure duty, since the appellate court had just articulated that very duty. Because the question whether respondent breached that duty was never tried, the Federal Circuit ordered the parties after oral argument to submit evidence in supplemental pleadings, and effectively conducted an *in camera* appellate trial behind closed doors. Needless to say, this process bears no resemblance to settled appellate procedure. The panel majority simply appointed itself jury, trial court, and reviewing court all at once.

Turning to patent law, the Federal Circuit held that a patent specification is irrelevant in construing a claim term unless it provides a clear disclaimer or disavowal of the term's dictionary definition. In so holding, the court failed to distinguish, or even address, a contrary line of circuit precedent (ratified by this Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996)) holding that a specification provides a claim term's presumptive meaning, and should be consulted before a dictionary definition. The court thereby ignored the public-notice function of a specification, which is part of the patent's public record, as opposed to a random dictionary definition, which is not. Moreover, the court ignored the extensive claim-construction evidentiary hearing below, where *respondent's own expert* conceded that the term "bus," as used in the specification to describe the invention, supported petitioners' construction of that critical claim term.

The real issue presented here, at bottom, is whether the Federal Circuit is above the law in patent cases. By definition, there can be no circuit split in such cases in light of the Federal Circuit's exclusive jurisdiction. But that fact should not allow the Federal Circuit to ignore basic rules of judicial procedure. The unique and specialized nature of the Federal Circuit's docket may have the advantage of promoting greater expertise and uniformity in patent cases, but it also has the corresponding

disadvantages of insularity and a willingness to second-guess agencies, trial courts, and juries in this area. It is thus imperative for this Court, in appropriate cases, to remind the Federal Circuit of its proper role in our federal judicial system.

The exceptional practical importance of this case only underscores the need for this Court's intervention. At stake here is nothing less than the future of the computer memory industry. Respondent Rambus sought to dominate that industry by participating in a standards-setting body while secretly amending its patent applications to cover the standards under consideration and then—after the standards were adopted and manufacturers spent vast sums implementing them—turning around and demanding extortionate licensing fees. Petitioners Infineon Technologies AG, Infineon Technologies North America Corp., and Infineon Technologies Holding North America Inc. (collectively "Infineon") refused to capitulate to those demands and, after Rambus sued Infineon for patent infringement, countersued Rambus for fraud. As the district court found, App. 208a-213a, and Rambus *did not even challenge* on appeal, App. 41a, Rambus destroyed and withheld material evidence, and its executives provided "false or misleading testimony." Although Rambus *conceded* at trial that it secretly drafted its patent applications to cover the JEDEC standard and the jury ruled for Infineon on the fraud claim, the Federal Circuit substituted its own view of the facts for the jury's and simply picked Rambus as the winner on that claim.

The decision below thus threatens to crown Rambus' fraudulent scheme with success. Because the law neither commands nor even permits that perverse result, this Court should either summarily reverse the decision below or set this case for plenary review. At the very least, this Court should call for the views of the United States, to provide the perspective of the Patent & Trademark Office, the Federal Trade Commission (which has sued Rambus under the antitrust laws for the conduct challenged here), and other interested federal agencies.

OPINIONS BELOW

The Federal Circuit's opinion is reported at 318 F.3d 1081 and reprinted in the Appendix ("App.") at 1a-66a. The unreported order denying the petition for panel rehearing and suggestion for rehearing *en banc* is reprinted at App. 67a-68a. The district court's unreported order construing Rambus' patent claims is reprinted at App. 69a-130a. The district court's order denying in part and granting in part Rambus' motion for judgment as a matter of law is reported at 164 F. Supp. 2d 743, and is reprinted at App. 131a-189a. The district court's order granting Infineon attorneys' fees is reported at 155 F. Supp. 2d 668, and is reprinted at App. 190a-228a.

JURISDICTION

The Federal Circuit entered judgment on January 29, 2003. Petitioners timely filed a petition for panel rehearing and suggestion for rehearing *en banc*, which was denied on April 4, 2003. The Federal Circuit stayed issuance of the mandate pending disposition of this petition on April 11, 2003. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

PERTINENT RULE PROVISIONS

The Seventh Amendment provides:

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

Rule 50 of the Federal Rules of Civil Procedure provides in pertinent part:

(a) Judgment as a Matter of Law.

(1) If during a trial by jury a party has been fully heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue, the court may determine the issue against that party and may grant a motion

for judgment as a matter of law against that party with respect to a claim or defense that cannot under the controlling law be maintained or defeated without a favorable finding on that issue. ...

(b) Renewing Motion for Judgment After Trial; Alternative Motion for New Trial. If, for any reason, the court does not grant a motion for judgment as a matter of law made at the close of all the evidence, the court is considered to have submitted the action to the jury subject to the court's later deciding the legal questions raised by the motion. The movant may renew its request for judgment as a matter of law by filing a motion no later than 10 days after entry of judgment .... In ruling on a renewed motion, the court may: (1) if a verdict was returned: (A) allow the judgment to stand, (B) order a new trial, or (C) direct entry of judgment as a matter of law. ...

STATEMENT OF THE CASE

A. Background

At the center of this case is the Joint Electron Devices Engineering Council ("JEDEC"), a cooperative group of companies that sets technical standards for electronic products. App. 132a n.1; 134a-135a. JEDEC standardization fosters competition and customer supply by allowing different manufacturers to produce interchangeable components. To maximize these benefits, JEDEC favors the adoption of "open" standards, free from restrictive intellectual-property rights. *Id.* JEDEC thus requires its participants to disclose any issued or pending patents that relate to its standardization work, *id.*, thereby allowing JEDEC participants to assess the potential impact of patents and patent applications before adopting new industry standards.

JEDEC Subcommittee 42.3 (JC-42.3) establishes standards for the design of random access memory ("RAM"), the memory chip found in virtually every personal computer in the world. In 1991, the subcommittee began developing the standard for an

advanced version of RAM, synchronous dynamic random access memory ("SDRAM"). App. 134a-136a. Among the subcommittee's members were petitioner Infineon, a manufacturer of semiconductor memory products, and respondent Rambus, a company that does not manufacture any products, but simply licenses its patent portfolio. *See id.*

Rambus participated in JEDEC for more than four years, from 1991 to 1995. App. 136a. During this period, Rambus tried in vain to promote its own proprietary memory design as the industry standard. As it became clear that JEDEC was on its way to adopting a different standard, Rambus resolved to obtain patent rights to the JEDEC standard. Accordingly, Rambus embarked on a process of morphing its pending patent claims in an attempt to cover the emerging SDRAM standard. App. 145a-146a. Indeed, Rambus memorialized this strategy in a confidential business plan:

> [W]e believe that Sync DRAMs infringe on some claims in our filed patents; and that there are additional claims we can file for our patents that cover features of Sync DRAMs. Then we will be in position to request patent licensing (fees and royalties) from any manufacturer of Sync DRAMs. Our action plan is to determine the exact claims and file the additional claims by the end of Q3/92. Then to advise Sync DRAM manufacturers in Q4/92.

App. 45a, 207a.

Rambus, however, never informed JEDEC that it was amending its patent applications to cover the emerging JEDEC standard. App. 136a. To the contrary, when JEDEC participants voted on features of the SDRAM standard, Rambus' representative did not check the box on the ballot indicating that Rambus had patent disclosures to make. Fed. Cir. App. 2742-46.

That Rambus' scheme was improper did not escape its attorneys. In 1992, soon after Rambus first began attending JEDEC meetings, its outside counsel, Lester Vincent, advised Rambus that "a finding of inequitable conduct could be a consequence of non-compliance with the JEDEC disclosure duty." App. 207a-208a. Then, in 1993, Vincent sent Rambus a detailed presentation on the consequences of patenting standards, which outlined, among other things, the elements of equitable estoppel and antitrust issues based on (1) misconduct at standards bodies and (2) duties of disclosure. Fed. Cir. App. 16466-87. In late 1995, Vincent advised the company to stop attending JEDEC meetings. Fed. Cir. App. 13045-47, 15944-48, 16018-19. Nevertheless, Rambus continued to attend such meetings through 1995, and did not formally withdraw until June 1996, *after* JEDEC had adopted an SDRAM standard. App. 4a, 136a.

Unaware that Rambus had filed patent claims intended to cover that standard, Infineon, like other JEDEC participants, invested hundreds of millions of dollars to develop JEDEC-compliant SDRAM products. All the while, Rambus monitored the ongoing development of an advanced SDRAM standard (DDR SDRAM) through secret informants with code names like "Secret Squirrel" and "Deep Throat." App. 47a. Rambus also continued to amend its pending patents to target those standards. App. 136a-137a. Rambus concluded that its "leverage" to extract licensing fees from JEDEC members would be greatest if it lay in wait. Fed. Cir. App. 16405.

B. The District Court Proceedings

Rambus pulled the trigger in June 2000 by informing Infineon that it owned patent rights covering the SDRAM technology, and seeking extortionate licensing fees. Less than two months later, Rambus filed this lawsuit claiming that Infineon's use of the JEDEC-compliant SDRAM technology infringed 57 claims of four Rambus patents, U.S. Patent Nos. 5,593,263, 5,954,804, 6,032,214, and 6,034,918. Infineon

promptly countersued Rambus for, among other things, fraud under Virginia common law for failing to disclose issued and pending patents relating to SDRAM during its JEDEC participation.

During discovery, the district court (Payne, J., E.D. Va.) agreed to pierce Rambus' attorney-client privilege under the crime-fraud exception with respect to communications concerning Rambus' JEDEC participation. After that ruling, Rambus' outside counsel produced damning documents that Rambus itself had failed to produce in discovery. As the district court found, Rambus had destroyed many of these documents through a bogus "document retention policy" designed to "get[] rid of documents that might be harmful in litigation." App. 211a. In addition, the district court found, "Rambus failed to list numerous documents on its privilege log, which (as it was ultimately learned) documented its fraudulent activity at JEDEC." App. 209a.

"[P]rodded by reference to the belatedly obtained documents," App. 210a, Rambus' CEO, Geoff Tate, and its JEDEC representative, Richard Crisp, were forced to admit that their earlier testimony was false. Crisp had testified that he "never, ever" participated in drafting Rambus' patent applications; in light of the concealed documents, he conceded that he had indeed participated in drafting those applications in an effort to capture the JEDEC SDRAM standard. *Id.* And Tate had testified that he did not believe that Rambus drafted claims to cover the JEDEC SDRAM standard; in light of the concealed documents, he conceded that Rambus *had* amended its claims to target that standard. *See id.*; *see also id.* at 145a.

In March 2001, after a three-day evidentiary hearing, the district court issued an opinion construing Rambus' patent claims as a matter of law. *See* App. 69a-130a. Rambus subsequently dropped the charge of infringement with respect to the '804 patent. App. 133a. The district court thereafter granted Infineon judgment as a matter of law on all of Rambus'

remaining patent claims, holding that Rambus failed to prove that Infineon had infringed those claims. *See id.*

Infineon's fraud counterclaims went to the jury, which—after a two-and-a-half-week trial—returned a verdict for Infineon on the fraud claim, and awarded both nominal and punitive damages. *See id.* Both sides filed post-trial motions. On August 9, 2001, the district court denied Rambus' post-trial motion for judgment as a matter of law with respect to the jury's fraud verdict as to the SDRAM technology. App. 131a-189a. The court also awarded Infineon attorneys' fees and costs. App. 190a-228a. Rambus appealed, and Infineon cross-appealed on some issues not relevant here.

C. The Federal Circuit Proceedings

The Federal Circuit reversed the judgment on both the fraud and patent-infringement issues.

With respect to fraud, a sharply divided panel held that the district court had erred in denying Rambus' post-trial motion for judgment as a matter of law under Rule 50(b) on the ground that no "substantial evidence" supported (1) the JEDEC disclosure duty found by the jury as a matter of *fact*, App. 24a-35a, or (2) the jury's "implicit" factual finding that Rambus breached the "relevant" disclosure duty, App. 2a, 35a-39a. Because the case was not tried under the majority's redefined disclosure duty, the panel contacted the parties after oral argument to request documents that were not in the appellate appendix, and then undertook its own *de novo* appellate factfinding. Judge Prost vigorously dissented from the panel's reversal of the fraud claim, noting that ample record evidence supported the factual findings underlying the jury verdict in Infineon's favor. *See id.* at 44a-66a.

With respect to patent infringement, the Federal Circuit held in relevant part that the trial court had erred in construing the critical claim term "bus" by looking primarily to the intrinsic evidence (the claims, specification, and prosecution history)

rather than the extrinsic evidence (a particular dictionary definition). *See id.* at 19a-22a. According to the Federal Circuit, a court is entitled to consult a patent specification only *after* consulting a dictionary to determine the meaning of disputed claim terms, and only to the extent it "clearly disavow[s] or disclaim[s]" the dictionary definition. *Id.* at 20a, 22a.

The Federal Circuit denied panel rehearing and rehearing *en banc*. *See id.* at 67a-68a. This petition follows.

REASONS FOR GRANTING THE WRIT

I. The Federal Circuit Violated Basic Principles Of Procedure And The Seventh Amendment By Reversing The Jury On A Factual Question And Ordering The Entry of Judgment For Rambus.

The Federal Circuit manifestly erred, as an initial matter, by holding that no "substantial evidence" supported (1) the JEDEC disclosure duty found by the jury as a matter of *fact*, App. 24a-35a, or (2) the jury's "implicit" factual finding that Rambus breached the "relevant" disclosure duty, App. 2a, 35a-39a. Both holdings are groundless. The decision below is a clear usurpation of the jury's role, and mere recitation of the "substantial evidence" standard cannot obscure that fact.

"[T]he rules governing the trial of patent cases are no different than in other types of civil litigation, and ... the scope of our review on appeal follows the same pattern." *Panther Pumps & Equip. Co. v. Hydrocraft, Inc.*, 468 F.2d 225, 227 (7th Cir. 1972) (Stevens, J.) (internal quotation omitted). Under Rule 50, a district court can grant judgment as a matter of law after trial only if "there is no legally sufficient evidentiary basis for a reasonable jury to find for [the nonmoving] party on that issue." Fed. R. Civ. P. 50. An appellate court reviewing the grant or denial of such a judgment applies that same standard. *See* 9 James W. Moore *et al.*, *Moore's Federal Practice* § 50.92[1], at 50-122-23 n.1 (3d ed. 1997) (citing cases from

every circuit). "If the appellate court finds, after drawing all reasonable inferences in favor of the nonmovant and making all credibility assessments in the nonmovant's favor, that sufficient evidence permits a rational juror to find for the nonmovant," then the appellate court must affirm the denial of a Rule 50 motion. *Id.* at 50-124 & n.2.

A. The Federal Circuit Erred By Holding That "Substantial Evidence" Did Not Support The JEDEC Disclosure Duty Found By The Jury.

The Federal Circuit first erred by holding that "substantial evidence" did not support the JEDEC disclosure duty found by the jury as a matter of *fact*.[1] Indeed, as Judge Prost pointed out in her dissent below, this is not even a close call; "there was more than substantial evidence for the jury" to find such a duty. App. 59a. What the panel majority did, plain and simple, was substitute its own view of the "duty that it believes JEDEC *should* have adopted," App. 60a (emphasis added), for the disclosure duty that the jury decided as a factual matter that JEDEC *did* adopt.

The panel majority conceded (and the parties agreed) that the scope of the JEDEC disclosure duty in this case is a matter of *fact*, not *law*. App. 7a. According to the panel majority, however, "a reasonable jury could *only* find that the duty to disclose a patent or application arises when a license under its claims reasonably might be required to practice the [final SDRAM] standard." App. 31a (emphasis added). The majority

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[1] It is a basic rule of procedure that where, as here, the jury returns a general verdict on the ultimate legal question (*i.e.*, Rambus committed fraud), the law presumes the existence of findings necessary to support the verdict reached (*i.e.*, Rambus had a disclosure duty and breached that duty). *See, e.g., Starceski v. Westinghouse Elec. Corp.*, 54 F.3d 1089, 1100 (3d Cir. 1995); *Span-Deck, Inc. v. Fab-Con, Inc.*, 677 F.2d 1237, 1241 & n.5 (8th Cir. 1982); *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 767 (5th Cir. 1980); *Tights, Inc. v. Acme-McCrary Corp.*, 541 F.2d 1047, 1055 (4th Cir. 1976); *Panther Pumps*, 468 F.2d at 228.

then proceeded to apply this standard by "determin[ing] that substantial evidence does not support the finding that [Rambus'] applications had claims that read on the [final] SDRAM standard." App. 36a.[2]

It is simply not true that the narrow disclosure duty articulated by the panel majority (much less the even narrower duty actually applied by the panel majority) is the *only* disclosure duty supported by substantial evidence. As Judge Prost explained, the record is replete with evidence that supports a broader JEDEC disclosure duty extending to issued or pending patents *related to* standards under consideration (regardless of whether eventually adopted) by JEDEC. App. 50a-60a; *see also* App. 144a n.3 (district court finding that "the JEDEC policy requires disclosure of all patents and patent applications which 'related' to the work of JEDEC").

Perhaps the most compelling evidence along these lines is testimony by *JEDEC officials and participants* describing the JEDEC disclosure duty. John Kelly (general counsel of the Electronic Industry Association and the person responsible for implementing JEDEC's patent policy) testified that this policy "required the early disclosure of patents and patent applications that are *or may be* required to comply with the standard." App. 53a (emphasis in original); *see also id.* at 141a. Gordon Kelley (chairman of JC-42.3 and IBM's JEDEC representative) testified that "[i]t's in complete violation of JEDEC requirements of openness and fairness with regard to notification of patents and pending patents" to secretly draft

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[2] The panel majority's *articulation* of its disclosure duty thus differs markedly from its *application* of that duty. As Judge Prost noted, while the panel majority declared that Rambus was required to disclosure claims that "reasonably might" be construed to read on the final SDRAM standard, App. 31a, the panel majority proceeded to apply that duty by assessing whether Rambus' claims *actually* read on the final SDRAM standard, *see id.* at 36a. *See id.* at 63a n.6 ("The majority states that its disclosure duty does not 'require a formal infringement analysis,' even though the majority then proceeds to determine whether the pending claims read on the standard.").

patent claims in an attempt to cover an emerging JEDEC standard. App. 53a; *see also id.* at 141a. Reese Brown, "a JEDEC consultant and member of Committee JC-42.3 for 25 years, testified that, during the SDRAM standardization process from 1991 to 1996, if a member had a pending patent application *relating to* the standardization effort, the member had a duty to disclose the pending patent." App. 141a-142a (emphasis added). And Willibald Meyer (Infineon's JEDEC representative) testified that "the holders of a patent or an application should make the committee aware ... that, the application of the patent which they held or had filed was in relationship to the work in JEDEC that we were doing." App. 53a-54a (emphasis omitted). By rejecting this direct trial testimony, the panel majority necessarily concluded not only that it knew more about the scope of the JEDEC disclosure duty than JEDEC officials and participants, but that the contrary testimony was not even "substantial evidence" upon which a rational jury could base a factual finding. That conclusion manifestly violates the Seventh Amendment's command that "no fact tried by a jury shall be otherwise reexamined in any Court of the United States." U.S. Const. amend. VII.

As Judge Prost noted, moreover, the interpretation of the JEDEC disclosure duty to which JEDEC officials and participants testified at trial is amply supported by documentary evidence. Section 9.3.1 of the October 1993 JEDEC Manual of Organization and Procedure, entitled "Committee Responsibility Concerning Intellectual Property," requires disclosure of "any knowledge they may have of any patents, or pending patents, that *might be involved* in the work they are undertaking." App. 51a, 146a (emphasis modified). In addition, the ballots used for voting in JC-42.3 stated that "[i]f anyone receiving this ballot is aware of patents *involving this ballot*, please alert the Committee accordingly during your voting response," and a witness testified that this language required disclosure of "intellectual property that is *related to*

that ballot or to the content of that ballot." App. 52a (emphasis in original). Indeed, as the district court noted, the key issue at trial was not the validity of the "related to" standard, but whether that standard applied to patent *applications* or only to *issued* patents. App. 141a, 194a.

The panel majority notably did not deny any of the foregoing evidence, but simply asserted that the JEDEC disclosure duty urged by Infineon was implausible, because (1) such a duty would be "amorphous" and "unbounded," and (2) the record also contained evidence that other JEDEC members did not comply with such a duty. App. 32a-33a. Neither of these assertions, however, remotely suggests that no "substantial evidence" supports the disclosure duty found by the jury.

At best, there was *conflicting* evidence on the scope of the JEDEC disclosure duty, which is one of the reasons why there was a trial here in the first place. Although the *jury* may have been entitled to disbelieve JEDEC's views on the scope of its own disclosure duty, the *Federal Circuit* was not. As Judge Prost explained: "JEDEC was free to formulate whatever duty it desired and it is not this court's job to rewrite or reinterpret the duty on the basis that it is unbounded (which I do not think it is)." App. 59a. Whatever the perceived virtues of the JEDEC disclosure duty adopted by the panel majority, its adoption transcends the judicial role.[3] Again, Judge Prost got it just

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[3] Indeed, the majority's concern with defining the boundaries of the JEDEC disclosure duty is especially misplaced here, because Rambus' conduct was not even in the gray zone. As the majority conceded, Rambus itself *believed* that its patent applications covered the standardized SDRAM technology, *see* App. 38a-39a, so Rambus is in no position to throw itself at the court's mercy as the victim of an unfairly vague duty, *see, e.g., Parker v. Levy*, 417 U.S. 733, 755-56 (1974). Certainly the majority's concern that "there is a staggering lack of defining details in the EIA/JEDEC patent policy," App. 34a, provides no license for an appellate court to redefine that policy; to the contrary, such a "lack of defining details" in the policy only underscores that the scope of the duty was a *factual* issue for the parties to argue to the jury—as they did.

right: "Having identified substantial evidence supporting a sufficiently broad duty of disclosure to support the jury's verdict, our job is done. The applicable standard of review does not permit us to go further, reweighing the evidence and determining *de novo* that the duty should be defined or applied in a different manner." App. 54a.[4]

Indeed, if anything, it is the disclosure duty imposed by the panel majority—a duty to disclose claims that actually "read on" the final JEDEC standard, *see* App. 36a—that is implausible and unworkable. By definition, the final JEDEC standard will not be known until the conclusion of the multi-year JEDEC process. A JEDEC participant obviously would have no way of knowing whether its patent claims read on the final standard until that standard is ultimately adopted, which by definition is too late, since the whole point of the disclosure duty in the first place is to prevent JEDEC from adopting standards subject to patent rights. As Judge Prost explained, the panel majority's emphasis on a comparison between patent claims and a final, adopted standard "does not take into account the possibility that, during the course of its work, the [standards body] considers, debates, rejects and amends various proposals as the standard evolves." App. 51a.

In addition, JEDEC participants have no way of knowing in advance how the courts might ultimately construe their patent

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[4] The panel majority's decision to reverse on the basis that "substantial evidence" did not support the disclosure duty advanced by Infineon at trial is particularly egregious because Rambus did not even raise this argument in its opening brief below. Instead, Rambus argued in that brief that the jury could not reasonably have found a *breach* of the disclosure duty, *however defined*. *See* Rambus Fed. Cir. Br. 26-27 ("The contours of the disclosure obligation were *murky at best* .... What is clear, though, is that *whatever the duty of disclosure*, Infineon did not prove that Rambus breached it.") (emphasis added). Appellate courts generally do not decide cases on the basis of arguments not advanced in the appellant's opening brief, because that allows "sandbagging" of the appellee. *See, e.g., Corson & Gruman Co. v. NLRB*, 899 F.2d 47, 50 n.4 (D.C. Cir. 1990) (*per curiam*).

claims—as underscored by this case, where the district court and the Federal Circuit construed the claims differently. It makes no sense to interpret the scope of the JEDEC disclosure duty retroactively by reference to the Federal Circuit's ultimate construction of the claims. As Judge Prost noted, "[t]he majority's application of its rule arguably requires a *Markman* claim construction, application of the doctrine of equivalents, a *Festo* analysis, and perhaps even a *Johnson & Johnston* analysis before anyone can say for sure whether a claim reads on a standard" and thus must be disclosed. App. 66a. As a practical matter, JEDEC could not operate under this standard.[5]

B. The Federal Circuit Erred By Holding That "Substantial Evidence" Did Not Support The Jury's "Implicit" Finding That Rambus Breached The "Relevant" Disclosure Duty.

The Federal Circuit compounded the error of imposing a new disclosure duty in this case by proceeding to hold that Infineon had not established that Rambus breached that new duty as a matter of law, and directing the entry of judgment in Rambus' favor. Because this case was not tried under the disclosure duty dictated by the panel majority, Infineon had no reason to put on evidence that Rambus breached such a duty. Contrary to the majority's assertion, there could have been no "implicit" jury finding that Rambus breached the "relevant" disclosure duty articulated by the panel majority, App. 2a, because the panel majority articulated that duty long *after* trial.

Although it is well-established that an appellate court has the raw *power* to order the entry of judgment in a case after holding that the trial court erroneously denied a motion for judgment as

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[5] Because the JEDEC disclosure duty is not tied to a patent infringement analysis, the fraud judgment in Infineon's favor can and should stand *regardless* of whether the district court erred in construing Rambus' patent claims. That is why Judge Prost would have affirmed the fraud judgment in Infineon's favor even though she agreed with the majority with respect to claim construction.

a matter of law, *see, e.g., Neely v. Martin K. Eby Constr. Co.*, 386 U.S. 317, 326 (1967); *cf. Weisgram v. Marley Co.*, 528 U.S. 440, 449-50 (2000), it is equally well-established that the exercise of that power is inappropriate where "the party whose jury verdict has been set aside on appeal ... may have valid grounds for a new trial," *id.* at 451 (quoting *Neely*, 386 U.S. at 325). Thus, in *Iacurci v. Lummus Co.*, 387 U.S. 86 (1967) (*per curiam*), this Court summarily reversed an appellate decision that in turn had reversed the denial of a motion for judgment as a matter of law. This Court held that the appellate court "should have ... remanded [the case] to the Trial Judge, who was in the best position to pass upon the question of a new trial in light of the evidence" and the appellate court's disposition. *Id.* at 88; *see also Weisgram*, 528 U.S. at 451 n.7 (discussing *Iacurci*). The *Iacurci* Court thus vacated the appellate court's judgment "insofar as it directed entry of judgment for respondent," and remanded the case to the appellate court "with instructions to remand to the District Court to determine whether petitioner is entitled to a new trial" in light of the appellate court's ruling. 387 U.S. at 88.

Here, rather than remanding the case for the district court to determine whether Infineon was entitled to a new trial in light of its ruling, the panel majority itself scoured the record to determine whether Infineon had presented evidence at trial to show that Rambus breached the JEDEC disclosure duty *as redefined by the panel majority*. (Indeed, because this issue had not been briefed, the panel majority repeatedly asked the parties for supplemental evidentiary submissions after the case was fully briefed and argued.) But that was an exercise in futility, because Infineon simply cannot be expected to have tried this case under ground rules different than those established by the district court, on pain of losing its case altogether on appeal if those ground rules turned out to be wrong. That is why, under basic norms of appellate procedure, if the record does not support affirmance under the standard defined by the appellate

court, the proper course is to vacate the judgment and remand the case for a new trial. *See, e.g., Pullman-Standard v. Swint*, 456 U.S. 273, 292 (1982).

And the panel majority erred not only by scouring the record to determine whether Rambus breached the panel majority's newly minted disclosure duty, but by saddling *Infineon* with the burden of identifying such evidence *on appeal*. *See* App. 39a ("If evidence of Rambus violating its duty to disclose exists, *Infineon* did not place it in the record or provide it to this court.") (emphasis added). Again, the panel majority thereby revealed a misunderstanding of the most basic tenets of appellate procedure. Infineon, as the plaintiff with respect to the fraud claim, bore the burden of proof with respect to that claim *at trial*. Once Infineon secured a judgment in its favor from the trial court, however, the burden shifted, and Rambus, as the appellant with respect to the fraud claim, bore the burden *on appeal* of demonstrating that there was an insufficient basis for the jury to conclude that Rambus had committed fraud. This clear error in the allocation of the burden of proof on appeal alone warrants summary reversal, because the Federal Circuit held only that Infineon had not shown *on appeal* that Rambus breached the supposedly narrower duty. App. 39a. Because Infineon had no obligation to make any such showing, the Federal Circuit's disposition cannot stand.

In any event, the record in this case contains more than substantial evidence to support a finding that Rambus breached even the disclosure duty defined by the panel majority—a duty to disclose "any patent or application with claims that a competitor or other JEDEC member *reasonably would construe* to cover the standardized technology.". App. 31a-32a (emphasis added). As Judge Prost noted, "even under the duty to disclose as defined and applied by the majority, I believe that substantial evidence shows that Rambus violated that duty." App. 60a n.4.

In this regard, Infineon showed at trial that *Rambus itself* construed its claims to cover the JEDEC SDRAM standards.

Indeed, *Rambus' own business plan* stated that "Sync DRAMs infringe claims in Rambus' filed patents and other claims that Rambus will file in updates later in 1992." App. 60a. In addition, Richard Crisp, Rambus' JEDEC representative, admitted that features of JEDEC's SDRAM standard "were discussed [at the JEDEC committee meetings] in some form or another, and we certainly had patent applications that covered aspects of those ... technologies." App. 63a; *see also* App. 62a, 145a (noting that Crisp met with Rambus' patent attorney to "add claims to our patent application broad enough to cover the SDRAM if the SDRAM uses mode register and programmable CAS latency"). Indeed, "Crisp often composed and sent email messages back to Rambus' executives and in-house counsel while discussions at JEDEC meetings were taking place," or "during recesses between standard-setting sessions." App. 145a n.4. These emails specifically "not[ed] instances where [Crisp] believed Rambus had pending claims that covered features of the evolving [SDRAM] standard." App. 61a. "The documents exchanged between Rambus' patent attorney Lester Vincent, Crisp and other Rambus employees ... proved the extensive efforts to revise patent applications or draft new ones for the purpose of securing patent protection for the very technologies chosen for incorporation into JEDEC's forthcoming standard." App. 145a-146a.

If this is not "substantial evidence" that Rambus *reasonably would construe* the claims to read on the JEDEC standard, it is hard to know what is. *See id.* at 63a-64a & nn. 5, 6; *see also id.* at 145a ("[T]he connection between Rambus' patents and the SDRAM standard was sufficiently established through testimony given, and the documents generated, by *Rambus'* executives.") (emphasis added); *see also id.* ("Infineon presented evidence too voluminous to catalog about Rambus' pervasive expansion of its pending patent portfolio in response to discussions held at JEDEC standard-setting meetings.").

The panel majority brushed aside this evidence on the ground that a JEDEC participant's "*subjective* beliefs, hopes, and desires are irrelevant." App. 38a (emphasis added). There is nothing "subjective," however, about the evidence showing that Rambus construed its claims to read on the JEDEC standards. Rather, that is *objective* evidence highly relevant to the very duty of disclosure defined by the panel majority—whether a JEDEC member "reasonably would construe [the claims] to cover the standardized technology." App. 32a. Evidence proving that Rambus itself *actually* construed its claims to read on the JEDEC standard is obviously evidence that a JEDEC member *reasonably* would construe the claims in this manner, except on the outlandish assumption (in which the panel majority did not purport to indulge) that Rambus' construction of its own claims was not only *mistaken* but *unreasonable*. That the panel majority nonetheless proceeded not only to reverse the judgment in Infineon's favor, but to order judgment in Rambus' favor without even allowing Infineon a new trial or remanding for the district court to address the new-trial issue, only shows how far the panel majority departed from settled practice and the Seventh Amendment.

II. The Federal Circuit Erred, And Deepened An Internal Circuit Split On A Fundamental Issue Of Patent Law, By Holding That An Extrinsic Dictionary Definition, Rather Than The Intrinsic Specification, Provides The Presumptive Meaning Of A Disputed Claim Term.

The Federal Circuit also erred by reversing the district court's construction of the critical claim term "bus," and therefore reversing the district court's entry of judgment as a matter of law in Infineon's favor on Rambus' infringement claim. Following a recent line of its cases, the Federal Circuit based its construction on the presumptive correctness of the term's definition as set forth in a dictionary outside the public patent record (so-called "extrinsic" evidence), even though the patent specification in the public record (so-called "intrinsic"

evidence) dictated a different construction. This new claim construction methodology is inconsistent with a long line of precedent from this Court and the Federal Circuit holding that the specification deserves primary weight in claim construction, and should be consulted *before* a dictionary. Accordingly, the Federal Circuit now has two irreconcilable lines of precedent on the fundamental question of how patent claims are to be construed—perhaps the single most important issue in patent law—and arbitrarily and capriciously picks between those two lines in particular cases.

This Court should not tolerate this judicial shell game, which leaves district courts, patent holders, the Patent & Trademark Office, and the patent bar in the dark about the scope of patents. All intellectual property owners will benefit from a clarification of the law that will allow them to ascertain consistently and reliably the scope of their patents, and those of their competitors. *See, e.g., Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) ("A patent holder should know what he owns, and the public should know what he does not.").

By holding that a dictionary definition presumptively provides the "ordinary meaning" of a disputed claim term, and that this meaning can be overcome only by a "clear disclaimer or disavowal" in the specification, App. 20a, 22a, the Federal Circuit turned upside-down its own seminal decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996), which dictates precisely the opposite approach to claim construction. Because patents are "fully integrated written instrument[s]," *id.* at 978, the *Markman* court placed dispositive emphasis on the so-called "intrinsic evidence" of claim construction: the claim language, specification, and prosecution history, *see id.* at 978-79 ("Claims must be read in view of the specification, of which they are a part."). Although a trial court may consult extrinsic evidence, including dictionaries, such "evidence is to be used

for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims." *Id.* at 981. Under *Markman*, thus, *intrinsic* evidence "is of primary significance in understanding the claims," *id.* at 980, and *extrinsic* evidence can be considered only when the intrinsic evidence does not provide a clear answer, *see id.* at 978-80.

In affirming, this Court specifically endorsed this approach, recognizing that claim construction involves a "necessarily sophisticated analysis of the whole document [the patent], required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." 517 U.S. 370, 389 (1996). This Court further stressed the primacy of intrinsic evidence by noting that a court considering extrinsic evidence must ascertain whether it "fully comports with the specification and claims and so will preserve the patent's internal coherence." *Id.* at 390; *see also United States v. Adams*, 383 U.S. 39, 49 (1966) ("[I]t is fundamental that claims are to be construed in light of the specifications and both are to be read with a view to ascertaining the invention."); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940) ("The claims of a patent are always to be read or interpreted in the light of its specifications."); *Bates v. Coe*, 98 U.S. 31, 38 (1878) ("[T]he claims of a patent ... must be reasonably construed, and in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portion of the specification to aid in solving the doubt or ascertaining the true intent and meaning of the language employed in the claims.").

Not surprisingly, many Federal Circuit decisions have followed *Markman* in making intrinsic evidence the linchpin of the construction analysis, and refusing to allow extrinsic evidence—and particularly a dictionary definition—to trump the intrinsic record. Thus, for example, in *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473 (Fed. Cir. 1998), the Federal Circuit emphasized that "the court *starts* the [claim construction] process" by reviewing the same sources as

would a person of ordinary skill in the field of invention, "*viz.*, the patent specification and the prosecution history." *Id.* at 1477 (emphasis added). "These documents have legal as well as technological content, for they show not only the framework of the invention as viewed by the inventor, but also the issues of patentability as viewed by the patent examiner." *Id.* Only *after* consulting the specification is it appropriate to consult a dictionary: "Courts must exercise caution lest dictionary definitions ... be converted into technical terms of art having legal, not linguistic, significance. The best source for understanding a technical term is the specification from which it arose .... When the specification explains and defines a term used in the claims, without ambiguity or incompleteness, *there is no need to search further for the meaning of the term.*" *Id.* at 1478 (emphasis added).

To the extent there is any question about the meaning of claim terms, "the specification acts as a dictionary," and is more reliable than the extrinsic evidence—including "dictionaries"—which thus may be consulted only *after* consulting the specification and only to the extent that "the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 1584 & n.6 (Fed. Cir. 1996); *see also id.* at 1582 (noting that the specification "[u]sually ... is dispositive" in claim construction, and "is the single best guide to the meaning of a disputed term"); *Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 705-06 (Fed. Cir. 1997) ("When construing a claim, a court should look *first* to the intrinsic evidence.... When the intrinsic evidence is unambiguous, it is improper for the court to rely on extrinsic evidence."); *Renishaw PLC v. Marposs Societa Per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) ("[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty."); *Toro Co. v. White Consol. Indus.*,

Inc., 199 F.3d 1295, 1299 (Fed. Cir. 1999) (rejecting dictionary definitions, and emphasizing that claim terms must be construed "in the context in which they were used by the inventor, considered by the examiner, and understood in the field of the invention").

Without attempting to distinguish the foregoing line of cases, on which Infineon relied, the Federal Circuit below looked instead to another, more recent, line of cases that places primary and dispositive emphasis on extrinsic dictionary definitions. *See, e.g., Inverness Med. Switz. GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1371-72 (Fed. Cir. 2002); *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-04 (Fed. Cir. 2002). These cases hold that dictionary definitions provide a claim term's "ordinary meaning," and thus accept such definitions as presumptively correct. Under this reverse-*Markman* approach, the patent specification is relegated to the back seat, and is relevant only insofar as it "clearly disclaim[s] or disavow[s]" the dictionary definition. *See* App. 20a (citing *Inverness*, 309 F.3d at 1372).

These two lines of cases are in direct and irreconcilable conflict. The *Markman* line of cases holds that a court should consult the specification *before* consulting a dictionary, and that recourse to the dictionary is permissible only if it does not contradict the meaning given by the specification. *See, e.g., Multiform Desiccants,* 133 F.3d at 1477-78; *Vitronics*, 90 F.3d at 1582. The reverse-*Markman* line of cases, in contrast, holds that a court should consult a dictionary *before* consulting the specification, and that recourse to the specification is permissible only if it does not contradict the meaning given by the dictionary. *See, e.g., Inverness*, 309 F.3d at 1371-72; *Texas Digital*, 308 F.3d at 1202-04; App. 20a. Both lines of cases cannot be correct.

The conflict between these two lines of claim construction cases creates an intolerable uncertainty in the law, and leaves district courts, patent holders, the Patent & Trademark Office,

and the patent bar at a loss about how to perform claim construction. As Judge Dyk recently acknowledged, "our decisions provide inadequate guidance as to when it is appropriate to look to the specification .... Until we provide better guidance, I fear that the lower courts and litigants will remain confused." *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1347 (Fed. Cir. 2001) (concurring opinion); *see also VLT Corp. v. Lambda Elecs., Inc.*, 238 F. Supp. 2d 347, 350 (D. Mass. 2003) (describing the Federal Circuit's precedents as "a bit schizophrenic on the relationship between the claim language and the specification of a patent"); *Borg Warner, Inc. v. New Venture Gear, Inc.*, 237 F. Supp. 2d 919, 928 (N.D. Ill. 2002) (discussing the "tension" in the Federal Circuit's precedent concerning the role of the specification in claim construction).[6]

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[6] This internal inconsistency has not escaped the attention of commentators:

> The Federal Circuit's lack of a consistent claim construction methodology becomes most apparent when trying to determine when extrinsic evidence, particularly dictionaries and treatises, may be considered. ... In many cases, the Federal Circuit determines the plain and ordinary meaning of the claim terms by relying on extrinsic evidence, such as dictionaries and even expert testimony. In other cases, the court ignores extrinsic evidence about the ordinary meaning of claim terms. In sum, not only are the claim construction canons ideologically flawed (and impossible to apply), but also the Federal Circuit does not approach claim construction consistently. Under the circumstances, uncertainty and unpredictability in patent cases will undoubtedly continue.

Gretchen Ann Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time Is Ripe for a Consistent Claim Construction Methodology*, 8 J. Intell. Prop. Law 175, 217 (2001); *see also* Ben Hatterbach, *Chickens, Eggs, and Other Impediments to Escalating Reliance on Dictionaries in Patent Claim Construction*, 85 J. Pat. & Trademark Off. Soc. 181, 182, 190 (2003) (noting that recent Federal Circuit cases on use of dictionary definitions "deviated from established principles of construction" and that earlier cases "struck a sensible balance between dictionaries and specifications"); Russell B. Hill & Frank P. Cote, *Ending the Federal Circuit Crapshoot: Emphasizing Plain Meaning in Patent Claim*

The Federal Circuit's reverse-*Markman* approach is inconsistent not only with *Markman*, but also with the public-notice function of patent law. *See, e.g., Bates*, 98 U.S. at 39 ("Accurate description of the invention is required by the law, for several important purposes: 1. That the government may know what is granted, and what will become public property when the term of the monopoly expires. 2. That licensed persons desiring to practise the invention may know during the term how to make, construct, and use the invention. 3. That other inventors may know what part of the field of invention is unoccupied."). Whereas the intrinsic specification is part of "the public record of the patentee's claim" examined by the Patent & Trademark Office ("PTO"), *Vitronics*, 90 F.3d at 1583, extrinsic dictionary definitions are not. Because "the public is entitled to rely" on the public record, allowing an inventor to broaden a claim's scope by reference to an extrinsic dictionary definition undermines the process. *Id.* "Allowing the public record to be altered or changed by extrinsic evidence introduced at trial ... would make ... meaningless" the public's right to rely on the intrinsic record. *Id.*; *see also Bell & Howell*, 132 F.3d at 705-06 & n.5; 6 Ernest Bainbridge Lipscomb III, *Walker on Patents* § 21:32, at 373 (3d ed. 1987) (specification entitled to greater weight than dictionary in claim construction "because the patentee presumably knew of the description, and may not have known [of] the dictionary, and because the reader of the patent may reasonably be expected to consult the description before he consults the dictionary").

Interpretation, 42 IDEA 1 (2002) ("The Federal Circuit continues to issue panel-specific contradictory decisions regarding the respective roles of the plain meaning of patent claim terms and the written description in patent claim interpretation."); Gregory J. Gallagher, *The Federal Circuit and Claim Construction: Resolving the Conflict Between the Claims and the Written Description*, 4 N.C. J.L. & Tech. 121, 121 (2002) ("Conflicting standards of claim construction confuse patent practitioners and the patent holders they represent about the scope of the patent's protection.").

Moreover, by giving an extrinsic dictionary definition priority over the intrinsic specification, the Federal Circuit's new reverse-*Markman* approach opens the door for courts to construe claim terms more broadly than the PTO. That potential anomaly is reason alone to reject this approach. *See, e.g., Festo*, 535 U.S. at 738 (adopting legal rule that is "respectful of the real practice before the PTO"); *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 32 n.6 (1997) (declining to adopt legal rule where "the PTO may have relied upon a [different] rule ... when deciding whether to [issue a patent] in the first place"); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 18-19 (1966) (decrying "a notorious difference between the standards applied by the Patent Office and by the courts," and adopting legal rule that would "bring about a closer concurrence between administrative and judicial precedent"). The specification, which "show[s] not only the framework of the invention as viewed by the inventor, but also the issues of patentability as viewed by the patent examiner," *Multiform Desiccants*, 133 F.3d at 1477, provides much surer guidance to the meaning of a disputed claim term than an extrinsic dictionary definition.

Indeed, a major problem with giving an extrinsic dictionary definition the main role in claim construction is that there is often no such thing as "a" dictionary definition. This case proves the point. The panel here simply chose one of the *many* definitions of the term "bus" in Rambus' technical dictionary alone. *See* Fed. Cir. App. 488-90. This approach brings no certainty to the law, but simply invites a "battle of the dictionaries." *See* 5A Donald S. Chisum, *Chisum on Patents* § 18.03[2][b][i][B]. at 18-138 (2002) ("Dictionaries are often of little assistance because they give multiple and alternative definitions of words."). "The dictionary does not always keep abreast of the inventor. It cannot. Things are not made for the sake of words, but words for things." *Festo*, 535 U.S. at 731 (internal quotation omitted).

Finally, this case provides an unusually good vehicle for resolving the split between the Federal Circuit's two lines of claim-construction cases. There is no question here that, in describing the invention, the patent specification uses the term "bus" as Infineon construes that term; indeed, as the district court noted, *Rambus' own expert* did not contest this point at the claim-construction hearing below. App. 85a; *see also id.* at 83a ("The specification clearly and unambiguously describes the bus of the invention to be the inventive multiplexed bus."); *id.* at 92a ("[T]he specification clearly demonstrates that when the inventors used the term 'bus' in the claims, they were referring to the new multiplexed bus described in the specification.").

Rambus thus did not dispute at trial that the specification was inconsistent with its cherry-picked dictionary definition; rather, Rambus argued only that the dictionary should trump the specification. App. 99a-100a. That argument is flatly inconsistent with the *Markman* line of cases, which holds that a court should not even *consult* a dictionary if the meaning of a disputed claim term is clear from the specification, and that it is improper to apply a dictionary definition inconsistent with the specification. *See, e.g., Multiform Desiccants*, 133 F.3d at 1478. Applying this line of cases, the district court had no trouble rejecting Rambus' proposed dictionary definition as (concededly) inconsistent with the specification. *See* App. 100a ("[T]he testimony of Rambus' expert, Dr. William Huber, is at odds with the intrinsic evidence and depends on a dictionary definition (other extrinsic evidence) that is not consistent with the many descriptions given by the inventors in the specification."). Thus, this case presents the split between the Federal Circuit's two lines of cases in unusually stark terms: if the *Markman* line of cases (applied by the district court below) governs, Infineon clearly wins on the construction of "bus." At the very least, this Court should clarify the confusion engendered by the Federal Circuit's two inconsistent lines of

cases regarding the role of the specification in claim construction.

This should not even be a close call. The Federal Circuit has sought to justify its reliance on dictionary definitions on the ground that a court cannot rely on a specification to read a limitation into an otherwise unambiguous claim. *See, e.g., Texas Digital*, 308 F.3d at 1204. A court, however, does not need to consult *either* a dictionary or the specification where a claim term's meaning is unambiguous. The issue presented here is whether the intrinsic specification or an extrinsic dictionary definition provides the presumptive meaning of a claim term that is *not* unambiguous. Looking to the specification for guidance under these circumstances does not "import" a limitation into a claim term, any more than would looking to a dictionary definition. Because the meaning provided in the specification is part of the intrinsic record, however, it is far more reliable and serves the patent law's public-notice function far better than an extrinsic dictionary definition. There is no issue in patent law more fundamental than this.

Under a proper interpretation of the term "bus," informed by the use of that term in the specification, the Federal Circuit should have affirmed the district court's claim construction, and hence the judgment in Infineon's favor on Rambus' patent claims.

CONCLUSION

For the foregoing reasons, this Court should grant the petition for writ of *certiorari*, and either summarily reverse the decision below or set the case for plenary review. At the very least, this Court should call for the views of the United States, to provide the perspective of the Patent & Trademark Office, the Federal Trade Commission, and other interested federal agencies.

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